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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,997	06/28/2005	Cheol-Su Lee	J323-053 US	9049
21706	7590	02/05/2009	EXAMINER	
NOTARO & MICHALOS P.C. 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			ANTONIENKO, DEBRA L.	
ART UNIT	PAPER NUMBER			
	3689			
MAIL DATE	DELIVERY MODE			
02/05/2009	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/540,997	Applicant(s) LEE, CHEOL-SU
	Examiner DEBRA ANTONIENKO	Art Unit 3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

- 1) Responsive to communication(s) filed on 10 November 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Final Office Action in response to communications received November 10, 2008, wherein:

Claims 1 and 2 have been amended;
Claims 4 and 5 have been cancelled; and
Claims 1-3 are pending.

Response to Amendment

2. Applicant's amendments to Claims 1 and 2 are sufficient to overcome the 35 USC 112, second paragraph rejection set forth in the previous Office Action. Claim 3 depends from Claim 1. Claims 4 and 5 have been cancelled. Therefore, the rejections to Claims 1-3 under 35 USC 112, second paragraph are withdrawn; the rejections to Claims 4-5 are moot.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1 and 2** are rejected under 35 U.S.C. 103(a) as being unpatentable over Miettinen et al., International Publication Number WO 01/54346 A1 (hereinafter referred

to as Miettinen) in view of Coppersmith et al. U.S. Patent Number 6,996,543 B1 (hereinafter referred to as Coppersmith).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Regarding Claim 1, Miettinen teaches a method for servicing an electronic certificate indicating an identification code (page 4, lines 34-37; base identity, first electronic identify); requesting creation and transmission of an electronic certificate (page 5, lines 1-5; id response, second electronic identity, second certificate) by inputting the identification code (identifier) into an electronic certificate server (identity registration authority; page 9, lines 35-38; Certificate Authority CA server), said electronic certificate comprising the identification code, a character image (Figure 3; Certificate ID), and a management program (Figure 2; manages the flow of data); creating the electronic certificate after confirming the identification code (page 5, lines 8-13 and lines 24-27; digitally signs); transmitting the electronic certificate through a wire/wireless network (page 5, lines 16-21); and displaying the character image of the electronic certificate on a display apparatus (Figure 3)... so that possession can be shown and authenticating the goods can be achieved even without the step of authenticating the goods (Figure 3; the user name shows direct ownership; the Passphrase Hash is for authentication).

That the electronic certificate will be used for a *big-name brand or genuine quality* verses any product or good does not serve to patentably distinguish the claimed invention over the prior art. In other words, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Miettinen does not explicitly disclose using an audio or visual tag, or a RFID tag before the first distribution or the first purchase and checking it at the first distribution or the first purchase. Also, Miettinen does not explicitly disclose being constructed so that only one electronic certificate can be created per goods when being created and said one electronic certificate can only move after being created. However, Coppersmith discloses smart tags created by the manufacturer and then checked after purchase (column 3, lines 24-28; column 4, lines 23-39). Also, Coppersmith discloses generating a single serial number (column 4, lines 18-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Miettinen to include a tag in order to provide easy access to the certification information. Also, it would have been obvious to create only one serial number or certificate per product, otherwise multiple identification numbers would defeat the purpose. This is well known, for example, the VIN used for automobiles.

Regarding Claim 2, Coppersmith further teaches wherein a secret code may be provided together with the identification code, in which the secret code (routing information) is able to be first open and known at the first distribution or the first purchase and the secret code being inputted together with the identification code (serial number) for creating the electronic certificate (1), otherwise the secret code may be transmitted at the first distribution or the first purchase, the electronic certificate (1) comprising the secret code (column 5, lines 8-32; column 6, lines 1-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to include more than one piece of information in the certificate in order to make authentication more precise.

5. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Miettinen in view of Coppersmith and further in view of Anderson, U.S. Patent Application Number 2005/0257055 A1 (hereinafter referred to as Anderson).

Regarding Claim 3, Miettinen further teaches wherein a database for the electronic certificate is constructed by the electronic-certificate creation server at the time of creation and transmission of the electronic certificate (page 5, lines 31-37; Figure 1; it is obvious to store data when created, otherwise it can not be used or transmitted again).

Miettinen and Coppersmith do not explicitly disclose said method further comprising the steps of transmitting results of the certification or authentication as for the electronic

certificate and/or information when certification or authentication is requested from the client through the authentication/management server, and achieving a change in ownership of the goods of the big-name brand or genuine quality by moving the electronic certificate to the client of a transferee together with transfer of the goods and cancelling the electronic certificate from the client of a transferor. However, Anderson discloses the ownership record can be recreated at any time by the network from internal resources in order to transmit to the device for authentication ([0021]-[0023]; Figure 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the capabilities to change ownership in order to further guard against theft.

Response to Arguments

6. Applicant's arguments filed November 10, 2008 have been fully considered but they are not persuasive.

7. In response to Applicant's argument that *Miettinen does not teach a method for servicing an electronic certificate for a big-name brand or genuine quality, in which the electronic certificate of the big-name brand or genuine quality itself can directly show ownership of the goods of the big-name brand or genuine quality by displaying an electronic certificate on the client system, in which authentication of the big-name brand or genuine quality can be achieved by authentication of the electronic certificate, and in which the electronic certificate can be transferred to another client of a*

new owner together with transfer of the goods of the big-name brand or quality

[emphasis added] (page 7 of Applicant's Remarks, November 10, 2008), Examiner maintains the obviousness rejection.

First, that the electronic certificate **will be used for a big-name brand or genuine quality** verses any product or good does not serve to patentably distinguish the claimed invention over the prior art. In other words, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Second, as cited in the previous Office Action, Figure 3 of Miettinen does show a display of a certificate that *can directly show ownership* since it shows a user name. Furthermore, *authentication...can be achieved by authentication of the electronic certificate* by using the Passphrase Hash, for example.

8. In response to Applicant's argument that neither Miettinen nor Coppersmith teaches a character image and a management program, Examiner notes that Figure 3 discloses a Certificate ID, which would be a character image. Also, Figure 2 shows how the flow of data is managed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

9. In response to Applicant's argument that *Anderson is directed to the need for a system and method for implementing and transferring device ownership in network devices in a manner that provides a barrier to device theft.* The intended use or reason for transferring ownership does not limit the steps of the method or the structure of the system. Therefore, such a difference does not effectively serve to patentably distinguish the claimed invention over the prior art.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kumagai et al., U.S. Patent Number 7,409,553 B2 discloses a method for a public key certificate generation and validation.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3689

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBRA ANTONIENKO whose telephone number is (571)270-3601. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DA

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
February 1, 2009